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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,976	08/21/2003	Shouhei Kozakai	0171-1012P	6358
2292 7590 02/23/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER PENG, KUO LIANG	
			ART UNIT 1712	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		02/23/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/23/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

Application No.

10/644,976

Applicant(s)

KOZAKAI ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/1/06 Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-16,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16,18 and 19 is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Translation of JP 05-004995

### **DETAILED ACTION**

1. The Applicants' amendment filed December 1, 2006 is acknowledged.  
Claims 2-3 and 17 are deleted. Claims 1, 6 and 16 are amended. Now, Claims 1, 4-16 and 18-19 are pending.
2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 090206) is/are removed.
3. Claim rejection(s) under 35 USC 103 in paragraph 9 of the previous Office Action (Paper No. 090206) is/are removed.
4. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

### ***Specification***

5. The disclosure is objected to because of the following informalities:

In the abstract (line 3), Applicants are advised to replace "having" with --  
consisting essentially of --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki (US 2002/0013386) in view of JP995 (JP 05-004995)

Aoki discloses a silicone adhesive as described in the prior Office actions.

For Claims 9-10 and 12-13, Aoki is silent on the use of component B) set forth in the instant claims. However, JP995 teaches the use of a compound containing **Si-H** and **alkoxysilyl** groups as represented by formula 1) ([0003]-[0008] and Examples) as a silane coupling agent (i.e., **adhesion promoter**). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate JP995's compound of formula 1) into Aoki's adhesive composition. The motivation is to enhance the adhesion of Aoki's adhesive to a substrate.

For Claims 11 and 14-15, JP955's compound of formula 1) where  $R^1$  can be a  $-(CH_2)_4-$  radical. JP955 is silent on a compound where the  $R^1$  is  $-(CH_2)_3-$  as claimed in the instant claims. However, a *prima facie* case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. "An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed

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compound, in the expectation that compounds similar in structure will have similar properties." *In re Payne*, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979).

7. Claims 1 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobori in view of JP995 (JP 05-004995).

Kobori discloses a silicone self-adhesive composition comprises a) to c) where the adhesion is important. (col. 2, lines 31-61 and col. 3, line 21 to col. 5, line 53 and Examples) Kobori is silent on the use of component B) set forth in the instant claims. However, JP995 teaches the use of a compound containing **Si-H** and **alkoxysilyl** groups as represented by formula 1) ([0003]-[0008] and Examples) as a silane coupling agent (i.e., **adhesion promoter**). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate JP995's compound of formula 1) into Kobori's adhesive composition. The motivation is to enhance the adhesion of Kobori's adhesive to a substrate.

*Allowable Subject Matter*

8. Claims 16 and 18-19 are allowed.

9. The following is an examiner's statement of reasons for allowance:

The present claims are allowable for at least the following reason(s) over the closest references: Aoki (US 2002/0013386), Dalbe (WO 00/32694/US 6 777 471)

Akoi discloses a silicone adhesive that contains 100 parts by weight of a condensation product of a diorganosiloxane that is hydroxyl terminated and contains not less than 500 repeat units with an organopolysiloxane that contains MQ units in a ration of 0.6 to 1.3. ([0011]-[0015]) Aoki is silent on the use of an organosiloxane-modified isocyanurate compound set forth in the instant claims. Dalbe teaches the use of **trimethoxysilylpropyl isocyanurate** in an adhesive composition derived from a mixture comprising a hydroxyl group end-capped polyorganosiloxane, an MQ resin containing hydroxyl groups. (col. 1, line 66 to col. 5, line 6, col. 7, line 52 to col. 8, line 10 and Examples) However, Akoi in view of Dalbe does not teach or fairly suggest specific component B) containing **allyl group(s)** set forth in Claims 16 and 18-19. Especially, Applicants show the unexpected results of using the claimed component B) in Examples.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

February 19, 2007

  
Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712